

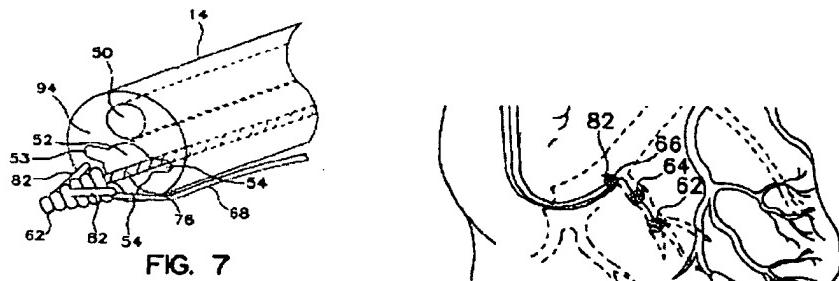
REMARKS

Claims 1-19 and 21-27 are currently pending in this application, and claims 20, 28-34 were previously cancelled. The amended claims set is provided herewith. By this Amendment, claim 1 has been amended. The independent Claim 1 has been amended for the purpose of clarity. No new matter has been added by the amendment. Applicant respectfully requests reconsideration based on the following remarks.

§ 103 Rejection of the Claims

Claims 1-19, 21-24 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dahl, et al., U.S. Patent No. 6,697,677, (hereinafter “Dahl”), in view of Wang, et al., U.S. Patent No. 5,462,545 (hereinafter “Wang”). Applicant respectfully traverses the rejection.

The Examiner is respectfully reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007). Applicant respectfully asserts that the purported substitution in the Office action of the coiling electrode (as taught by the Wang reference) for the extendable member of the Dahl reference destroys the function of the extendable member of the Dahl reference and thus the Office Action fails to set out a *prima facie* case of obviousness. Dahl discloses a system and method that is capable of delivering multiple electrode assemblies to predetermined implant sites. *See* col. 3, lines 12-14. The electrode assembly 62 includes an expandable member 82, which expands when the electrode assembly 62 is deployed to maintain the electrode assembly 62 at a predetermined implant site. *See* col. 7, lines 21-23. As illustrated in the redacted portion of FIGS. 7, 17 below, expandable member 82 expands by branching out, relative to electrode assembly 62, to maintain the electrode assembly 62 in place. *See e.g.* col. 13, lines 32-33; FIGS. 7, 17.



The Office action cites the Wang reference for its teaching of an electrode that can coil. Wang fails to teach an electrode system having an expandable member that maintains the electrode in place. To the contrary, the teaching in Wang conflicts with the teaching of an expandable member that expands to maintain the electrode assembly in place. Rather, Wang discloses an electrode portion 30 that is stretchable and bendable such that it can be formed into a desired electrode configuration. In particular, Wang teaches a coiled electrode portion 30 allows more surface area of the electrode portion 30 to be placed in contact with the tissue of interest than is achievable with an uncoilable electrode portion. *See* col. 6, lines 25-33. According to § 2143.01 of the MPEP, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The stretchable and bendable coiled electrode portion 30 of the Wang reference would defeat a stated purpose of the Dahl reference to maintain the electrode assembly in place. Thus, it would not be obvious to modify Dahl's teachings to achieve the feature of maintaining the electrode assembly in place because the coiled electrode would thereby be rendered unsatisfactory for its intended purpose.

Moreover, the Office action fails to provide an articulated rationale for the combination of the Dahl and Wang references. The Office Action summarily rejected the pending claims as purportedly simply being a substitution of prior art elements for a combination that would yield a predictable result. However, this unfounded assertion in the Office Action is wholly incorrect and confusing to the applicant, since (as discussed above) the electrode disclosed by the Wang reference would render the electrode system disclosed by Dahl inoperable for at least the intended objective of maintaining the electrode in place. Further, it is noted that Wang is not

concerned in any manner with leads, but is merely directed at a catheter system. Independent Claim 1, among other things, teaches an extendable member having a distal portion adapted to curl upon itself when not-constrained to form an electrode, the extendable member being received at least in part within a lead body for axial movement between a retracted position in which the distal and proximal portions are constrained within the lead body; and an extended position in which the proximal portion is retained within the lead body and the distal portion is deployed out the tip of the lead body such that the distal portion curls upon itself to form an electrode.

Accordingly, Applicant respectfully asserts that a *prima facie* case of obviousness cannot be maintained against the pending claims by the combination of Dahl and Wang, and withdrawal of the rejection is respectfully requested.

Claims 25 and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dahl, et al., U.S. Patent No. 6,697,677, in view of Wang, et al., U.S. Patent No. 5,462,545, and further in view of Giele, et al., U.S. Patent No. 5,531,783. Applicant respectfully traverses this rejection.

The Office Action cites Giele for the proposition that it teaches a coating which helps retain the tines close to the lead body. Applicant respectfully challenges the propriety of this assertion. As disclosed in the Giele reference, coating 20 merely covers the portion of the helix 18 to provide a smooth outer surface. See col. 3, lines 8-12. This coating is molded so as to harden and fix around the helix thereby covering it. See col. 3, lines 60-62. However, nothing in the Giele disclosure teaches or suggests that the coating keeps the underlying helix straight or that the coating is dissolved by electrical current as stated, in claims 25-26. Rather, Giele simply teaches that the coating provides a smooth outer form that simply covers the underlying helix tip.

Moreover, in the rejection, Dahl and Wang are the primary references and are applied in the same manner as applied against claim 1. The Giele reference fails to remedy the deficiencies noted above with respect to the Dahl and Wang references. Additionally, claims 25-26 properly

Application No.: 10/805,028
Reply to Office Action of: August 13, 2008

depend from claim 1 and being dependent claims are allowable therewith. Accordingly, Applicant respectfully requests withdrawal of this rejection.

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 763.505.0429 or by e-mail at john.w.albrecht@medtronic.com with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 13-2546.

Respectfully submitted,

Date: 11-13-08


John W. Albrecht
Registration No. 40,481
MEDTRONIC, INC.
710 Medtronic Parkway NE, M.S.: LC340
Minneapolis, Minnesota 55432-5604
Telephone: (763) 505-0429
Facsimile: (763) 505-0411
CUSTOMER NO.: 27581